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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,056	09/22/2003	Sean McFerran	1001.1708101	7830
28075	7590	10/09/2007		
CROMPTON, SEAGER & TUFTE, LLC 1221 NICOLLET AVENUE SUITE 800 MINNEAPOLIS, MN 55403-2420			EXAMINER GRAY, PHILLIP A	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 10/09/2007	DELIVERY MODE PAPER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/667,056  
Filing Date: September 22, 2003  
Appellant(s): MCFERRAN, SEAN

**MAILED**

OCT 09 2007

Group 3700

\_\_\_\_\_  
Sean McFerran  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 6/25/2007 appealing from the Office action mailed 9/12/2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

<b>5030210</b>	<b>Alchas</b>	<b>07-1991</b>
<b>5,807,349</b>	<b>Person et al.</b>	<b>09-1998</b>

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alchas (U.S. Patent Number 5,030,210) in view of Person et al. (U.S. Patent Number 5,807,349).

Alchas discloses an elongate shaft (30), an elongate guidewire port (40), a polymer sheath disposed over the elongate guidewire port (34), wherein the passage is configured to permit guidewire access through the elongate guidewire port while remaining substantially fluid tight in use when no guidewire is provided through the passage. Alchas does not disclose a passage comprising an angled slit extending radially through the polymer sheath at an angle such that the slit has a depth that is greater than a thickness of the polymer sheath.

Person discloses an angled slit (82 and 84) extending radially through a polymer sheath at an angle such that the slit has a depth that is greater than a thickness of the polymer sheath. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the sheath of Alchas with the angled slit as described by Person for opening to increased pressure in the lumen to permit the infusion of fluids from the lumen of the catheter into the vessel in which the catheter is positioned (col. 5, lines 17-30). As to claim 15-17, (see Person 82 and 84).

Alchas in view of Person discloses the claimed invention except for the slit parallel along the longitudinal axis. It would have been an obvious matter of design choice to position the slit parallel along the longitudinal axis, since applicant has not disclosed that the parallel slit over the angled slit solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the slightly angled slit as disclosed in the prior art of record. Or in the alternative one of ordinary skill in the art would have made a modification to make the slit parallel to the longitudinal axis because it would be an obvious modification and it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950), and that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

#### **(10) Response to Argument**

**Applicant's first argument** is directed towards the rejection under 35 U.S.C. 103(a) as being unpatentable over Alchas (U.S. Patent Number 5,030,210) in view of

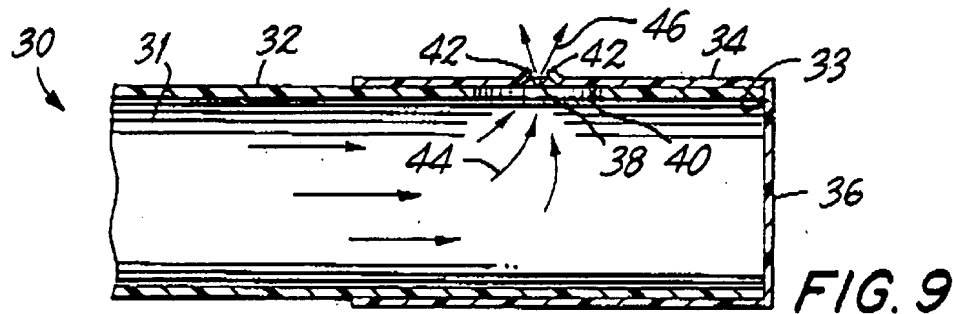
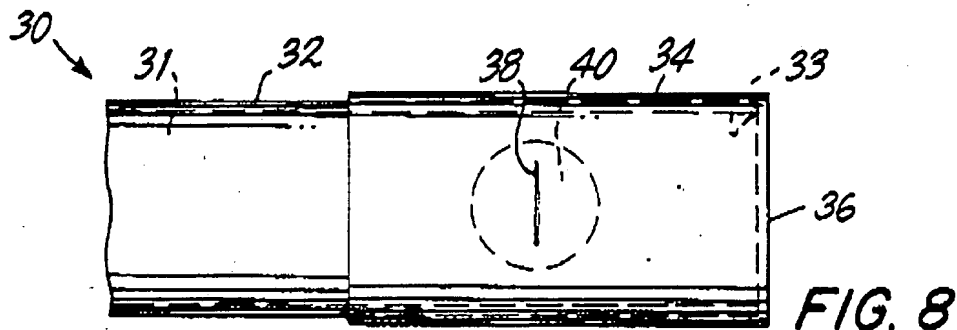
Person et al. (U.S. Patent Number 5,807,349). Applicant argues that the prior art references must teach or suggest all of the claimed limitations, particularly Alchas does not disclose an "elongate guidewire port".

It is examiners position that Alchas does disclose an "**elongate** guidewire port". During examination the claim limitations are to be given their broadest reasonable reading. Examiner and applicant agree that the "guidewire port" (as in element 40 of figure 8) is clearly disclosed, see page 6 and 7 of applicant's brief. Applicant is arguing that an "**elongate**" guidewire port is not disclosed. Applicant's evidence that the guidewire port 40 is not "elongate" is because of the circular appearance from the "top down" view shown in figure 8. But shown in the longitudinal cross section or "side view" shown in figure 9, the guidewire port 40 is **elongate**.

Examiner is of the position that the word "elongate" means

1. Made longer; extended.
2. Having more length than width; slender

As defined in the American Heritage Dictionary. Examiner is reading the word "elongate" as an adjective, which modifies the element of the "guidewire port". It is examiners position that the guidewire port 40 has "more length than width", is "slender" (as shown from the cross sectional view and configuration of element port 40 of figure 9), and the port is "made longer, extended" (extended and made longer then port 38).



As shown in figure 9, guidewire port 40 would have a three dimensional configuration of being shaped like a circular disc or "dime"-like appearance. It is examiners position that a circular disc is greater in length then width in a side view. Also the first definition of **elongate** is "made longer, extended" is shown and is a transitional adjective, and that the guidewire port 40 is made longer and extended from port 38, or from being a smaller size configuration.

Under this level of scrutiny the prior art of record does indeed disclose an "elongate guidewire port" since the element (40) is fully capable of all structural, functional, spatial, and operational limitations associated with the claim language of "Elongate guidewire port". Further that the elongate guidewire port of Alchas "may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art" because the "drawings and pictures can anticipate claims" because "they clearly

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show the structure which is claimed" (an **elongate** guidewire port). Therefore the rejection stands and is proper.

**Applicant's second argument** is directed towards the rejection under 35 U.S.C. 103(a) as being unpatentable over Alchas (U.S. Patent Number 5,030,210) in view of Person et al. (U.S. Patent Number 5,807,349). Applicant argues that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings". Particularly applicant argues that Person teaches "a pair of slits" not "a slit".

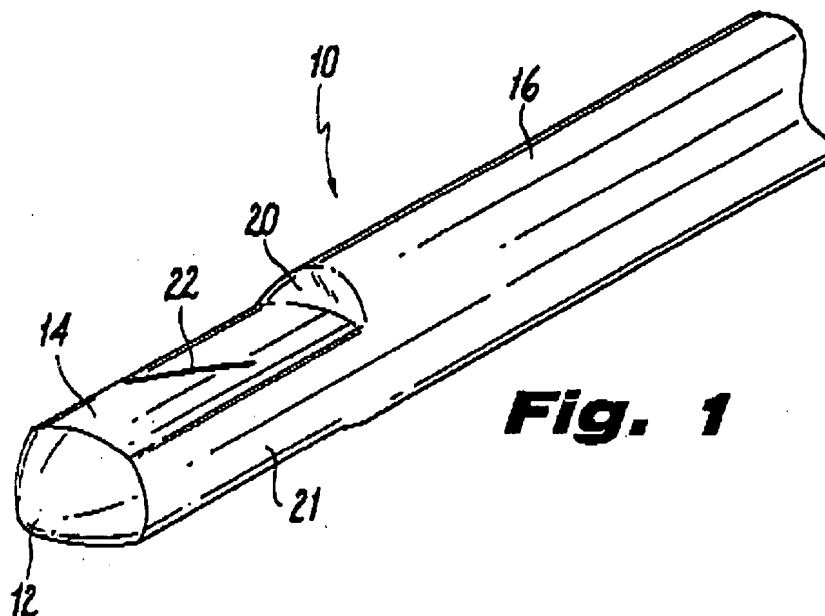
It is examiner's position that Person discloses and teaches "a slit" and/or "a pair of slits" and that both of these teachings would satisfy the claim limitation of "a slit".

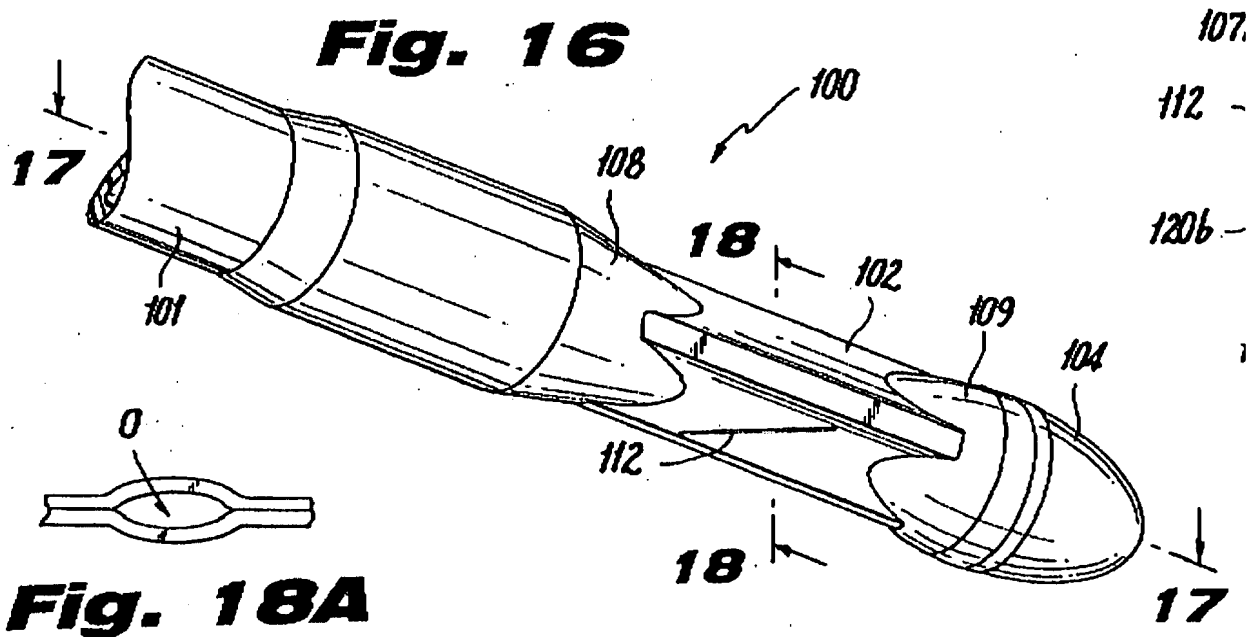
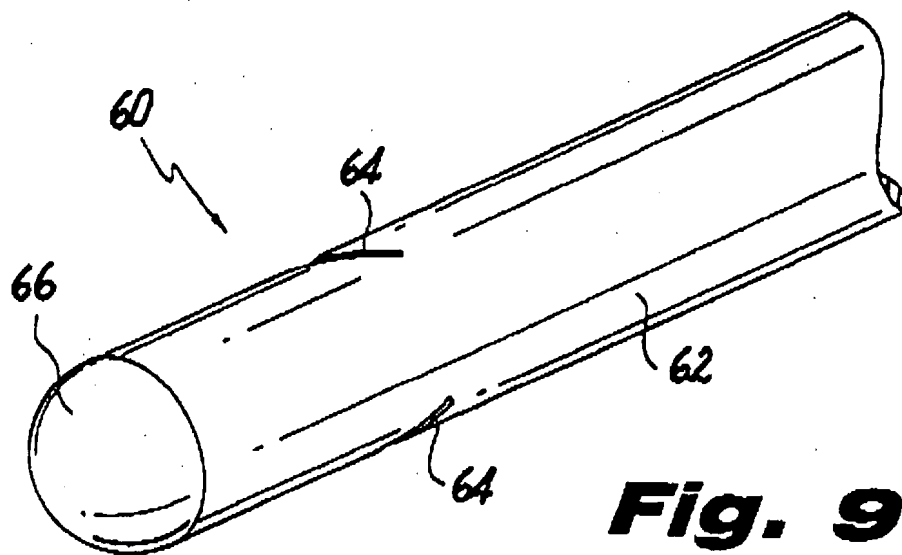
Taking applicant's argument that Person discloses "a pair of slits", not "a slit" (see applicant's brief at page 8), these "pair of slits" would anticipate the claims because applicant has used the claim language of "a single lumen microcatheter, comprising: ...including a passage comprising an angled slit...". Note that applicant has used the word "**comprising**" both describing what is contained in the "microcatheter" and what is contained in the "passage". It is examiners position that "a pair of slits" taught by Person would satisfy this comprising "a slit" claim language limitation. The term "comprising" renders the claim open for the inclusion of unspecified elements, the term "consisting of" closes the claim as to the inclusion of elements other than those recited in the claims. Ex parte Davis 80 USPQ 448, 450 (PatBdApp 1948). The applicant has



used the word comprising, (twice) to modify what is contained in the "microcatheter" and "passage", the "pair of slits" taught by Person would include "a slit" and therefore satisfy and disclose what is specified in the claim language limitation of "a slit".

Person is not silent with regard to a single angled slit, and what one would do with it or make it, (as argued in applicant's brief of page 8). Examiner is of the position that Person does teach and disclose "a slit". Examiner draws attention to claim 1 of person and the language of "at least **one** valve positioned exclusively within the portion of reduced thickness so as to communicate the lumen with an exterior of the tube, **the** valve being oriented in a plane which is at an angle to a longitudinal axis of the tube" [emphasis added]. Examiner also draws attention to the fact, in Person, that a valve (as in 22) comprises a **single** "slit" (see paragraphs beginning at column 4 line 6).





Figures 1, 9 and 16, of Person, for example, disclose "a slit" in the singular sense (see slit 22 of figure 1, 64 of figure 9, or 112 of figure 16) This is evidence that an angle

**single** slit was disclosed in the prior art of record, Person, and any obvious modifications thereof.

Lastly applicant argues that Person “teaches away” from aligning the slit parallel to the longitudinal axis of the shaft. Examiner is of the position that Person does not “teach away” from aligning the slit parallel to the longitudinal axis of the shaft.

Simply that there are differences between two references is insufficient to establish that such references “teach away” from any combination thereof. A reference is not limited to its preferred embodiment, but must be evaluated for all of its teachings, including its teachings of non-preferred embodiments. The disclosures in a reference must be evaluated for what they would fairly teach one of ordinary skill in the art. Specifically, in considering the teachings of a reference, it is proper to take into account not only the specific teachings of the reference, but also the inferences that one skilled in the art would reasonably have been expected to draw from the reference. In addition, it is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. Those of ordinary skill in the art are presumed to have some knowledge of the art apart from what is expressly disclosed in the references.

Applicant relies on the statement in Person that “in each of the embodiments, it is preferred that the valves are positioned at an angle to the longitudinal axis of the catheter in an area of reduced thickness to increase the size of the opening for ingress and egress of fluids” (see Person column 2 lines 30-34) as evidence of Person “teaching away” (as in applicant’s brief on page 9). It is known that applicant bears the

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burden of explaining where the evidence submitted by applicant establishes the non-obviousness of the instant invention. It is examiners position that Applicant has not met this burden, and further that Person does not "teach away" from this obvious modification, of aligning the slit parallel to the longitudinal axis of the shaft.

Examiner is of the position that applicant has merely given proof that Person discloses that it is "**preferred**" that the valves are positioned at an angle to the longitudinal axis. This "preference" does not amount to a "teaching away" bout rather an alternative.

The Person disclosures, when evaluated for what they would teach one of ordinary skill in the art would be that the valve or slits could be parallel but that an angle is preferred. In addition, it is proper to take into consideration not only the teachings of Person, but also the level of ordinary skill in the art, apart from what is expressly disclosed in the references. Under this evaluation someone of ordinary skill would know that the slit could be disclosed parallel to the longitudinal axis to adjust the ingress and egress of fluids to a desired rate and performance level. Furthermore Applicant has not disclosed that the parallel slit over the angled slit solves any stated problem or is for any particular purpose, and it appears that the invention would perform equally well with the slightly angled slit as explicitly disclosed in Person. It is examiners position that it would have been an obvious matter of design choice to position the slit parallel along the longitudinal axis, or in the alternative one of ordinary skill in the art would have made a modification to make the slit parallel to the longitudinal axix because it would be an obvious modification and it has been held that rearranging parts of an invention involves

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only routine skill in the art, and that a mere reversal of the essential working parts of a device involves only routine skill in the art, and that one would be motivated to do this to adjust the ingress and egress of fluids to a desired rate and performance level.

Therefore the rejection stands and is proper.

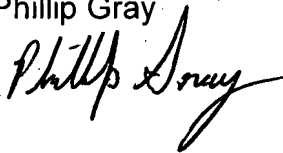
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Phillip Gray



Conferees:

Kevin Sirmons

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER



Janet Baxter

